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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,739	01/02/2002	Thomas J. Taylor	6976 C	3736

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EXAMINER
REDDICK, MARIE L

ART UNIT	PAPER NUMBER
1713	6

DATE MAILED: 06/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

HG

Office Action Summary	Application No.	Applicant(s)	
	10/038,739	TAYLOR ET AL.	
	Examiner	Art Unit	
	Judy M. Reddick	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 March 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,5,7,8 and 10-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 5, 7, 8 and 10-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

*2. Claims 1, 5, 7, 8, 10, 11, *13, *14, 15, 17, 18 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

The recited "molecular weight" per claims 1, 5, 13 and 14 constitutes indefinite subject matter as per it not being readily ascertainable as to if "weight average" or "number average" is intended, the two being substantially different. See Ex Parte Simpson(61 USPQ 2d 1009).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

*4. Claims 1, *5, 7, 8 and 10-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,331,350. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of U.S.'350 defined, basically, as a fiberglass binder, comprising an aqueous solution of a polycarboxy polymer governed by a number average MW of less than 5,000, a polyol such as triethanolamine and an alkali metal salt of a phosphorous-containing organic acid catalyst wherein, the ratio of carboxyl group equivalents to hydroxyl group equivalents is in*

the range of from about 1/0.65 to 1/0.75 clearly overlap in scope with the instantly claimed invention which is defined basically as a fiberglass binder, comprising an aqueous solution of a polycarboxy polymer having a molecular weight of 5,000 or less, a polyol such as triethanolamine and an alkali metal salt of a phosphorous-containing organic acid catalyst wherein, the ratio of equivalents of hydroxyl groups to equivalents of carboxyl groups is in the range of from 0.6/1 to 0.8/1.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> *A person shall be entitled to a patent unless –*
>
> *(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*
>
> *(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> *(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

6. Claims 1, 5, 7, 8 and 10-20 stand rejected under 35 U.S.C. 102(b or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Arkens et al(U.S. 5,427,587), Arkens et

al(U.S. 5,661,213), Arkens et al(U.S. 5,763,524), Arkens et al(U.S. 6,136,916), Chen et al(U.S. 6,274,661 B1) or EP 583,068 A1(Arkens et al).

Each of the prior art supra disclose and exemplify aqueous compositions, useful as a fiberglass binder, defined basically as containing a polycarboxy polymer which includes a polyacrylic acid addition polymer having at least two carboxylic acid groups, anhydride groups or salts thereof, governed by a molecular weight of at least about 300 per each of Arkens et al and at least about 100 per Chen et al and comfortably overlapping in scope with the polycarboxy polymer per the instantly claimed invention, a polyol which includes triethanolamine and comfortably overlapping in scope with the polyol component per the instantly claimed invention other conventional additives such as sodium phosphite and/or hypophosphite and comfortably overlapping in scope with the catalyst per the instantly claimed invention wherein, the ratio of equivalents of hydroxyl groups/equivalents of carboxyl groups falls within the scope of the instantly claimed invention. Each of patentees therefore anticipates the instantly claimed invention. See each of patentees in their entirety and specifically the Abstract, col.1, lines 6-30, col. 4, lines 58-68, the Runs and claims of Arkens et al'587, the Abstract, col. 1, lines 10-24, col. 2, lines 55-62, col. 4, lines 21-31, the Runs and claims of Arkens et al'213, the Abstract, col. 1, lines 10-24, col. 4, lines 21-31, the Runs and claims of Arkens et al'524, the Abstract, col. 1, lines 10-25, col. 3, lines 45-67, col. 4, lines 21-31, the Runs and claims of Arkens'916, the Abstract, col. 4, lines 9-16, the paragraph bridging cols. 4-5, the Runs, especially Run 1, and claims of Chen et al'661, the Abstract, page 2, lines 1-10 and 54-58, page 4, lines 33-43, the paragraph bridging pages 4-5, the Runs and claims of EP'086.

Response to Arguments

7. Applicant's arguments filed 03/18/03 have been fully considered but they are not persuasive.

<u>Relative to the Molecular Weight</u>—It is urged and maintained that the recited "molecular weight" is indefinite as per reasons of record. Any basic Polymer Chemistry textbook

would provide a basis for distinction between "number average MW" and "weight average MW" and contrary to Counsel's belief, "Daltons" is merely a unit of mass and does not necessarily translate to "number average MW" as argued.

**The omission of claims 13 and 14 in the statement of rejection per paragraph # 2 per paper no. 4, 12/18/02 was an obvious oversight. It is clear that these claims contain the same issue as the listed claims and therefore this is not a New Issue for applicants. An apology is extended to applicants for any inconvenience that this may have caused.*

Relative to the OTDP rejection over the claims of U.S. 6,331,350—It is urged an maintained that the claims of U.S.'350 defined, basically, as a fiberglass binder, comprising an aqueous solution of a polycarboxy polymer governed by a number average MW of less than 5,000, a polyol such as triethanolamine and an alkali metal salt of a phosphorous-containing organic acid catalyst wherein the ratio of carboxy group equivalents to hydroxyl group equivalents is in the range of from about 1/0.65 to 1/0.75 clearly overlap in scope with the instantly claimed invention which is defined basically as a fiberglass binder, comprising an aqueous solution of a polycarboxy polymer having a molecular weight of 5,000 or less and a polyol such as triethanolamine and an alkali metal salt of a phosphorous-containing organic acid catalyst wherein, the ratio of equivalents of hydroxyl groups to equivalents of carboxyl groups is in the range of from 0.6/1 to 0.8/1. To this end, the Double Patenting rejection is deemed proper.

**The omission of claim 5 in the Double patenting statement of rejection per the previous Office Action(paper no. 4, 12/18/02) was clearly an obvious oversight. Claim 5 has never been indicated as being allowable as it was included in the statement of the rejection based on the prior art as well as in item 6 of PTO FORM-326 in the previous Office Action(paper no. 4, 12/18/02). This is not a New Issue for applicants. An apology is extended to applicants for any inconvenience that this may have caused.*

Relative to Arkens et al'587, '213, '524, '916, Chen et al'661 and Arkens et al(EP'086)—The crux of Counsel's arguments appears to hinge on there being no specific example(s) to

the tune of a molecular weight of less than 5,000 coupled with a hydroxyl/carboxy group equivalents ratio in a range of from 0.6 to 0.8/1 although broad ranges for the ratios of equivalents of hydroxyl groups to equivalents of carboxy groups are disclosed and to this end, Counsel is cordially reminded that a reference is evaluated, as a whole, for what it teaches and in noway limited to the working examples, i.e. the specification need not contain an example if the invention is otherwise disclosed in such a manner that one skilled in the art will be able to practice it without an undue amount of experimentation as provided for under the guise of In re Borkowski, 422 F. 2d 904, 908, 164 USPQ 642, 645(CCPA 1970).

Correcting the dependency of claim 7 can preclude a rejection, in the future, under 35 U.S.C. 112, second paragraph. The rejection is not being made at this time as per the outstanding rejections still appear to be valid.

Conclusion

8. The prior art to Smith et al(U.S. 3,387,061) listed on the attached PTO FORM-892 is cited as of interest in teaching an aqueous solution of a composition containing a polycarboxylic acid, a polymeric polyether, an inhibitor such as triethanolamine and other conventional adjutants and is considered merely cumulative to the prior art supra.

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR
May 28, 2003